

**REMARKS**

Claims 1-4, 29-33, and 39-41 were pending in this application.

Claims 1-4, 29-33, and 39-41 have been rejected.

No claims have been amended.

Claims 1-4, 29-33, and 39-41 remain pending in this application.

Reconsideration and allowance of Claims 1-4, 29-33, and 39-41 are respectfully requested.

**I. REJECTION UNDER 35 U.S.C. § 102**

Claims 1-4, 29-33, and 39-41 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,229,810 to Gerszberg (“*Gerszberg*”). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

A. CLAIMS 1-4

The Applicant previously amended Claim 1 to recite “one or more terminal emulators each comprising at least one service proxy for ... setting up services between [a] plurality of data sources and [a] plurality of telephones.” The Office Action asserts that *Gerszberg* anticipates these elements of Claim 1. (*Office Action, Page 2, Last paragraph*). In particular, the Office Action states that the Patent Office interprets the “access network server complex” (element 38) of *Gerszberg* as a “terminal emulator” recited in Claim 1.

While the Patent Office is free to interpret *Gerszberg*, the Patent Office may only do so in ways that are supported by the disclosure of *Gerszberg*. The Office Action cannot interpret *Gerszberg* in ways that are totally and completely unsupported by *Gerszberg*.

In this case, the Office Action cites no portion of *Gerszberg* supporting its interpretation that the “access network server complex” is a “terminal emulator.” *Gerszberg* fails to disclose that the access network server complex performs any type of action to emulate a terminal. In fact, *Gerszberg* contains no mention of any component performing any type of emulation.

To the extent that the Patent Office relies on *Gerszberg* as inherently disclosing these elements of Claim 1, the burden is on the Patent Office to prove that the access network server complex of *Gerszberg* must operate using a terminal emulator. (*MPEP* § 2112). In particular, the Patent Office must provide a “rationale or evidence tending to show inherency.” (*MPEP* § 2112). However, the fact that a certain characteristic “may occur or be present in the prior art is not sufficient to establish the inherency.” (*MPEP* § 2112). To establish inherency, the Patent Office must provide evidence showing that “the missing descriptive matter is necessarily present

in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” (*MPEP* § 2112).

The Office Action provides no “rationale” or “evidence” explaining why the “access network server complex” of *Gerszberg* must operate using a “terminal emulator.” Figures 4A and 4B of *Gerszberg* clearly illustrate the two components that form the access network server complex. Neither of these components includes a terminal emulator. As a result, the Patent Office is unable to show that *Gerszberg* inherently discloses the use of “one or more terminal emulators” as recited in Claim 1.

For these reasons, the Patent Office has failed to show that Claims 1-4 are anticipated by *Gerszberg*. Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and allowance of Claims 1-4.

**B. CLAIMS 29-33 AND 39-41**

For the second time, the Patent Office has rejected Claims 29-33 (independent Claim 29) and 39-41 (independent Claim 39) without providing any rationale or explanation as to how *Gerszberg* anticipates each element/feature recited in these claims. As noted in response to the previous Office Action, Claims 29-33 and 39-41 recite different elements than Claims 1-4. However, the Office Action again rejects Claims 29-33 and 39-41 using the same rationale used to reject Claims 1-4. As a result, the Office Action cannot maintain the rejection of Claims 29-33 and 39-41.

The burden is on the Patent Office to show that a reference anticipates all elements of a

claim. If the Patent Office cannot meet its burden, the claim is allowable. Since the Office Action has failed to show that each and every element/feature of Claims 29-33 and 39-41 is anticipated by *Gerszberg*, the Patent Office has failed to meet its burden and the Applicant respectfully requests withdrawal of the § 102 rejection and allowance of Claims 29-33 and 39-41.

## II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

DOCKET NO. RO3797US (NORT10-00093)  
SERIAL NO. 09/307,356  
PATENT

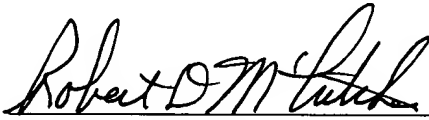
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 5/21/2004

  
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